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2001P15526US

PATENT APPLICATION
09/990,844

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REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 19, 2007. At the time of the Office Action, Claims 1-14 and 16-21 were pending in this Application. Claim 15 was previously canceled without prejudice. Claims 1-4, 11-14, and 16-21 are allowed. Claims 5 stands rejected. Claims 6-10 were objected to. Claim 5 has been amended. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 5 is rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,644,603 issued to Ushirokawa ("*Ushirokawa*"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

In the previous response to office action, Applicant stated that *Ushirokawa* discloses a method in which certain symbols are not included into the sequence estimation wherein a power threshold level is used to reduce the number of symbols. The Examiner stated in the above mentioned office action that the current independent claim 5 is broad enough to read on any

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deterministic criteria or values, included but not limited to the power value as disclosed by *Ushirokawa*.

Applicant respectfully disagrees. The present specification would not support such a broad interpretation of claim 5. However, to further prosecution, Applicant amended independent claim 5 such that the step of generating the reduced trellis is performed by calculating only path metrics for states in which the previous symbol has the determined symbol value. Therefore, claim 5 limits the comparison of the previous symbols to their respective symbol value.

As stated in the last response to office action, *Ushirokawa* merely reduces the number of symbols by using a power threshold value but still requires to calculate all metric calculations for the selected symbols. The Examiner stated that the present independent claim does not include the limitation of reducing the number of calculations in a trellis. Applicant respectfully disagrees. The present independent claim 5 is directed to a method for determining a reduced trellis. *See*, claim 5, preamble. Even though the preamble of a claim generally does not constitute a limitation, it in fact does constitute a limitation if the respective term is repeated in the body of the claim. In claim 5, the step of "generating said reduced trellis by calculating only path metrics for states in which the previous symbol has the determined symbol value" repeats the term "reduced trellis." Thus, claim 5 includes the limitation of reducing a trellis. Moreover, a trellis generally comprises all possible metric calculation. Claim 5 clearly states that the reduced trellis is generated by calculating only path metrics for states in which the previous symbol has the determined symbol value. Hence, the trellis according to claim 5 has a reduced number of path metrics.

Ushirokawa neither discloses nor mentions a method to determine a reduced trellis. Any trellis calculated by *Ushirokawa*, whether the trellis has all available symbols or a reduced number of symbols, still populates the trellis with all possible metric calculations. *Ushirokawa* clearly lacks this feature.

In summary, *Ushirokawa* does not disclose the limitations of independent Claim.

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Allowable Subject Matter

Claims 1-4 and 13-21 are allowed. The Examiner indicated that Claims 6-10 would be allowable if rewritten. However, as stated above, Applicant believes that all claims are allowable in view of the cited prior art.

CONCLUSION


Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 19-2179.

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